

**Amendment and Response**

Applicant: Micheal Talley et al.

Serial No.: 10/718,179

Filed: November 20, 2003

Docket No.: 200309402-1

Title: A METHOD FOR EDITING A PRINTED PAGE

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**REMARKS**

The following remarks are made in response to the Office Action mailed August 7, 2007, in which claims 1-22 were rejected. Claims 5 and 20-22 have been cancelled. With this Response, claims 1-4, 6-16, and 19 have been amended and new claims 23-24 have been added. Claims 1-4, 6-19, and 23-24 are pending in the application and are presented for reconsideration and allowance.

**Claim Objections**

Applicants have amended claims 1 and 15 in accordance with the suggestions made in the Office Action, thereby obviating the objections.

**Claim Rejections under 35 U.S.C. § 103**

In the Office Action, claims 1-5, 8, 10-14, 16-18 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ericson U.S. Patent Publication 2002/0054778 (the Ericson Publication) in view of Garland et al. U.S. Patent 5,544,045 (the Garland Patent).

Applicants have canceled claims 5 and 20-22.

Applicants' independent claim 1 recites a method of editing a printed page.

The Ericson Publication teaches using a position-coding pattern 3 on a surface 2 of paper sheet 1 and a device, such as a hand-held digital pen, for reading the position-coding pattern 3 and for making marks on the paper sheet 1 (See at least Figures 1, 4, and 6; Paragraphs 19, 23, 25, 58, 71-72). An electronic representation of information written on the sheet is produced by continuously determining the position of the pen on the sheet of paper by reading the position-coding pattern 3 while writing on the surface 2 (of paper sheet 1) with the pen. See Paragraph 25. The Ericson Publication further teaches that the text of the document is analyzed by associating each letter with its position and at the same time searching for editing symbols with corresponding positions. See, for example, Paragraph 19 and 71. The editing information is interpreted by a computer and changes are made to a stored document using the editing information. See, for example, Paragraph 19.

In sharp contrast, Applicants' independent claim 1 recites a method of editing a printed page comprising, among other things, **automatically scanning, via a multifunction**

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**printer**, a printed page includes text and at least one handwritten edit symbol. Unlike the arrangement provided in the Ericson Publication, Applicants' claimed method does not require a user to hold a digitizing pen to read position-coding patterns on a sheet of paper.

Applicants' independent claim 1 further recites electronically identifying from the scanned printed page, via the multifunction printer, at least one electronic edit symbol which corresponds to the at least one handwritten edit symbol, and then electronically and **automatically modifying, at the multifunction printer, a first page description file** using the at least one electronic edit instruction to create a second page description file that includes the text modified according to the at least one handwritten edit symbol.

In particular, as noted in Applicants' specification at page 10, lines 4-20, modifying the page description file includes reflowing the page description file via the electronic edit instruction to insert, remove, or rearrange a sequence of text elements within each line of text so that the reflow of the page description file provides a line-by-line determination of what will be printed.

Accordingly, because the modification is performed via a page description file, Applicants' independent claim 1 does not use or require position information from a position-coded sheet, as occurs in the Ericson Publication. The Ericson Publication does not address using a page description file to edit a document.

Finally, the Ericson Publication does not disclose automatically modifying, **at a multifunction printer**, the first page description file using at least one electronic edit instruction, as recited in Applicants' independent claim 1 because the Ericson Publication discloses the use of a computer to partially or wholly implement editing information for a document. See, for example, Paragraph 19.

The Garland Patent fails to cure the deficiencies of the Ericson Publication. In particular, the Garland Patent fails to disclose editing a printed page based on at least one **handwritten** edit symbol on a printed page, as recited in Applicants' independent claim 1. Instead, the Garland Patent teaches away from this claimed feature by teaching a method of editing via a CRT or LCD by an individual using a keyboard, mouse, or electronic pen (See, for example, Column 1, lines 63-67) or editing via an optical character recognizer that reads a digital representation of a scanned document and uses pre-stored cues to substitute information in a pre-arranged manner (See Column 2, lines 29-55) such as filling in a name

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and address of the owner of a computer. This former example in the Garland Patent is not automatic while the latter example apparently does not involve handwritten edits on the printed page that was scanned.

Accordingly, the Garland Patent also fails to teach electronically identifying from the scanned printed page, via the multifunction printer, at least one electronic edit symbol, which **corresponds to the at least one handwritten edit symbol, and** therefore also fails to teach electronically and **automatically** modifying the first page description file using an electronic edit instruction to create a second page description file that includes the text modified **according to the at least one handwritten edit symbol.**

Accordingly, one cannot combine the Ericson Publication and the Garland Patent and arrive at Applicants' independent claim 1.

For at least these reasons, the Ericson Publication and the Garland Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 1, and therefore Applicants' amended independent claim 1 is patentable and allowable over the Ericson Publication and the Garland Patent. Dependent claims 2-4 and 8 are believed to be allowable as they further define patentably distinct independent claim 1.

Applicants' independent claim 11 recites a method of using a multifunction printer, **independent of and separate from a computer**, to automatically edit a printed document. The method comprises scanning an entire printed document via the multifunction printer **without regard to position information on the printed document**, with the printed document including text and at least one handwritten edit. The method also includes electronically identifying, via the scanned printed document, the at least one handwritten edit on the printed document and determining at least one corresponding electronic edit instruction. A first electronic printable file, corresponding to the printed document, is electronically obtained. The method also comprises electronically and automatically applying, to the first electronic printable file, the at least one electronic edit instruction, **without regard to position information from the printed document**, to create a second electronic printable file including modified text.

In sharp contrast, the Ericson Publication performs its editing method via a computer.

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In addition, the Ericson Publication teaches using position information from a position-coded sheet 1 to implement editing a document, whereas the method of Applicants' independent claim 11 recites automatically scanning an entire printed document via the multifunction printer **without regard to position information on the printed document**, with the printed document including text and at least one handwritten edit. Moreover, the Ericson Publication fails to teach **automatically scanning an entire printed document**, as recited in Applicants' independent claim 11, because the Ericson Publication teaches the use of a hand-held digitizing pen (see, for example, Figures 1, 4, 6 and Paragraphs 19, 23, 25, 58, and 71-72) to read a position-coded pattern on a sheet.

In further contrast to the Ericson Publication, Applicants' independent claim 11 recites electronically and automatically applying, to the first electronic printable file, the at least one electronic edit instruction **without regard to position information from the printed document** to create a second electronic printable file including modified text.

Finally, as admitted in the Office Action, the Ericson Publication does not teach that its steps are performed via a multifunction printer.

The Garland Patent fails to cure the deficiencies of the Ericson Publication. In particular, the Garland Patent fails to disclose automatically editing a printed page based on at least one **handwritten** edit on a printed page, as recited in Applicants' independent claim 11. The Garland Patent teaches editing via a CRT or LCD by an individual using a keyboard, mouse, or electronic pen (See, for example, Column 1, lines 63-67) or editing via an optical character recognizer that reads a digital representation of a scanned document and uses pre-stored cues to substitute information in a pre-arranged manner (See Column 2, lines 29-55) such as filling in a name and address of the owner of a computer. This former example in the Garland Patent is not automatic while the latter example apparently does not involve handwritten edits on the printed page that was scanned.

Accordingly, the Garland Patent also fails to teach electronically and automatically applying, to a first electronic printable file, at least one electronic edit instruction **without regard to position information from the printed document** to create a second electronic printable file including modified text, wherein the electronic edit instruction is identified from at least one handwritten edit on a scanned printed page, as recited in Applicants' independent claim 11.

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Therefore, one cannot combine the Ericson Publication and the Garland Patent and arrive at Applicants' independent claim 11.

For at least these reasons, the Ericson Publication and the Garland Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 11, and therefore Applicants' amended independent claim 11 is patentable and allowable over the Ericson Publication and the Garland Patent. Dependent claims 12 is believed to be allowable as they further define patentably distinct independent claim 11.

Applicants' independent claim 13 recites a multifunction printer comprising a memory, a scanner, an optical character recognition function, and an edit manager. The scanner is configured for obtaining an electronic image file of at least one printed page that includes a text and at least one handwritten symbol and for storing the electronic image file in the memory. The optical recognition function is configured to perform an optical character recognition on the electronic image file to recognize, without regard to position information on the at least one printed page, the at least one handwritten edit symbol as at least one electronic edit symbol, and configured to obtain a first page description file corresponding to the text of the at least one printed page. The edit manager is stored in the memory and configured, in communication with the optical recognition function, to automatically implement an electronic edit instruction corresponding to the electronic edit symbol to the first page description file to create a second page description file that includes the text modified according to the at least one handwritten edit symbol. The edit manager implements the electronic edit instruction at the multifunction printer independent of, and separate from, a computer.

For substantially the same reasons presented for the patentability of independent claims 1 and/or 11, the Ericson Publication and the Garland Patent fail to teach, suggest, or reasonably make obvious the features recited in Applicants' independent claim 13 that provides a multifunction printer. In particular, the Ericson Publication and the Garland Patent fail to teach, suggest, or reasonably make obvious a multifunction printer including (among other things) : (1) an optical recognition function configured to perform an optical character recognition on the electronic image file to recognize, **without regard to position information on the at least one printed page, the at least one handwritten edit symbol** as

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at least one electronic edit symbol; and (2) an edit manager stored in a memory and configured, in communication with the optical recognition function, to **automatically** implement an electronic edit instruction corresponding to the at least one electronic edit symbol to the first page description file to create a second page description file that includes the text modified according to the at least one handwritten edit symbol, wherein the edit manager implements the electronic edit instruction at the multifunction printer independent of, and separate from, a computer.

Accordingly, one cannot combine the Ericson Publication and the Garland Patent and arrive at Applicants' independent claim 13.

For at least these reasons, the Ericson Publication and the Garland Patent fail to teach, suggest, or reasonably make obvious Applicants' amended independent claim 13, and therefore Applicants' amended independent claim 13 is patentable and allowable over the Ericson Publication and the Garland Patent. Dependent claims 14 and 16-18 are believed to be allowable as they further define patentably distinct independent claim 13.

Claims 6, 7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claims 1 and 2 above, and further in view of Yano et al. U.S. Patent No. 6,910,184 (hereinafter Yano). Dependent claims 6, 7, and 9 are believed to be allowable based on their dependency from patentably distinct independent claim 1.

Claims 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claim 13 above, and further in view of Yano. Dependent claim 19 is believed to be allowable based on its dependency from patentably distinct independent claim 13.

Claims 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ericson and Garland as applied to claim 13 above, and further in view of Kanematu U.S. Patent No. 7,130,066 (hereinafter Kanematu). Dependent claim 19 is believed to be allowable based on its dependency from patentably distinct independent claim 13.

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In light of the above, Applicants respectfully request withdrawal of the above rejections of claims 1-4 and 6-19 under 35 U.S.C. §103 and respectfully request allowance of these claims.

**New Claims**

Applicants present new claim 23, depending from independent claim 1, and new claim 24, depending from independent claim 11. New claim 23 recites that electronically modifying the first page description file comprises using the multifunction printer exclusively, independent of and separate from a computer, to electronically modify the first page description file. New claim 24 recites that the first electronic printable file comprises a first page description file and that the second electronic printable file comprises a second page description file.

Applicants respectfully submit that new claims 23 and 24 define over the references and therefore, favorable consideration and allowance of claims 23-24 is respectfully requested.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 1-4, 6-19, and 23-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-4, 6-19, and 23-24 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(h)(i). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Paul S. Grunzweig at Telephone No. (612) 767-2504, Facsimile No. (612) 573-2005 or Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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